

REMARKS

The present amendment is submitted in response to the Office Action dated May 12, 2010, which set a three-month period for response, making this amendment due by August 12, 2010.

Claims 1-13 are pending in this application.

In the Office Action, claims 1-13 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1, 3-7, and 9-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,146,452 to Pekarske in view of U.S. Patent No. 4,701,630 to Annunziata et al. Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Pekarske in view of Annunziata and further in view of U.S. Patent No. 7,330,661 to Jackson et al. Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Pekarske in view of Annunziata and further in view of U.S. Patent No. 7,013,328 to Monse et al.

In the present amendment, claims 1 and 13 were amended to address the formal rejection under Section 112, second paragraph.

To more clearly define the invention over the art of record, claim 1 have been amended to define an "*industrial machine in the form of a printing machine, comprising a communication system configured for operating the industrial machine...*" Method claim 13 was amended in a similar manner.

The primary reference to Pekarske fails to disclose that any controls and drives that are configured and used to control and/or drive an industrial machine, more specifically a printing machine. Again, Pekarske relates to telephone networks and Annunziata to Local Area Networks, so that neither of these references discloses or suggests a communication system comprising a control and/or drive network that is specifically configured for operating an industrial machine, which implicitly also comprises controls/drives.

Likewise, none of the other secondary references cited in combination with Pekarske discloses the newly added features of claims 1 and 13, so that even if the references were combined as proposed, the resulting device would not include all of the features of the invention.

When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ***ACS Hosp Sys., Inc., v. Montefiore Hosp.***, 221 USPQ 929, 932, 933 (Fed. Cir. 1984). Since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in MPEP section 2143.01.

The application in its amended state is therefore believed to be in condition for allowance. Action to this end is courteously solicited. However, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss

appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', written over the printed name.

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